

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

David E. MCDYSAN et al.

Application No.: 09/723,501

Group Art Unit: 2157

Filed: November 28, 2000

Examiner: Gold, A.

Customer No.: 25537

Attorney Docket: RIC00043

Client Docket: 09710_1236

For: EXTERNAL PROCESSOR FOR A DISTRIBUTED NETWORK ACCESS SYSTEM

TRANSMITTAL OF APPEAL BRIEF

Commissioner for Patents

Washington, DC 20231

Sir:

Submitted herewith in triplicate is Appellant's Appeal Brief in support of the Notice of Appeal dated January 25, 2007.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees and please credit any excess fees to such deposit account.

Respectfully submitted,

DITTHAVONG MORI & STEINER, P.C.

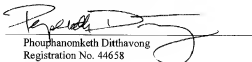
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APPEAL BRIEF

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

This Appeal Brief is submitted in support of the Notice of Appeal dated January 25, 2007.

I. REAL PARTY IN INTEREST

MCI, Inc. is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related Appeal or Interference.

III. STATUS OF THE CLAIMS

Claims 2 through 18 and 20 through 38 are pending in this Application. Claims 2 through 18 and 20 through 38 have been finally rejected in an Office Action dated August 25, 2006. It is from the final rejection of claims 2 through 18 and 20 through 38 that this Appeal is taken.

Claims 3, 4, 13, 21 through 23, 26, 29, and 31 are original claims; claims 2, 5 through 10, 12, 14 through 18, 20, 24, 25, 27, 28, 30, and 32 through 38 have been previously presented; claims 1 and 19 have been cancelled.

IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the issuance of the Final Office Action dated August 25, 2006.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 37 is directed to an external processor for a network access system having a programmable access device. (Specification page 11, lines 15-18). The claimed processor comprises: a message processor configured to parse a message for determining a type of communication service (Specification page 17, lines 28-32); a service controller configured to receive the message if the type of communication service corresponds to the service controller (Specification page 17, lines 30-32), wherein the service controller determines a policy based on the message and generates a control signal according to the policy (Specification page 19, lines 1-15); and a programmable access device (PAD) controller configured to receive the control signal for configuring a PAD to enforce the policy with respect to a network connection between a first

network and a second network (Specification page 17, lines 19-28, page 18, lines 21-25, and FIG. 2).

Independent claim 38 is directed to a method of providing a network access system with an external processor and having a programmable access device (Specification page 11, lines 15-18). The claimed method comprises: receiving a network message and parsing the message to determine a type of communication service with a network processor of the external processor (Specification page 17, lines 28-32); determining a policy in response to the message with a service controller of the external processor (Specification page 17, lines 32-32, and page 19, lines 1-15); generating and transmitting a control signal according to the policy (Specification page 18, lines 21-31); and establishing a configuration of a programmable access device (PAD) to enforce the policy using the control signal with a PAD controller of the external processor in order to connect a first network and a second network (Specification page 17, lines 19-28, page 18, lines 21-25, and FIG. 2).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 2 through 6, 9, 20 through 24, 27, 37, and 38 stand finally rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Miles et al.;

2. Claims 7, 8, 10, 11, 25, 26, 28, and 29 stand finally rejected under 35 U.S.C. § 103 for obviousness predicated upon Miles et al. in view of Gai et al.

3. Claims 12, 13, 30, and 31 stand finally rejected under 35 U.S.C. § 103 for obviousness predicated upon Miles et al. in view of Bullock et al.; and

4. Claims 14 through 18 and 32 through 36 stand finally rejected under 35 U.S.C. § 103 for obviousness predicated upon Miles et al. in view of Bowman-Amuah.

VII. ARGUMENT**Grouping of Claims.**

As the sole issue before the Honorable Board of Patent Appeals and Interferences (the “Board”) it is the impropriety of the Examiner’s determination that the Declaration submitted pursuant to 37 C.F.R. § 1.131 (Evidence Appendix) is not effective to antedate Miles et al., Appellants will not separately argue the patentability the claims. Rather, all of the appeal claims stand or fall together with exemplary claim 37.

The rejection of claims 2 through 6, 9, 20 through 24, 27, 37, and 38 under 35 U.S.C. § 102 for lack of novelty as evidenced by Miles et al.

As previously noted, the pivotal issue in this Appeal is whether the Examiner erred in holding that the Declaration submitted pursuant to 37 C.F.R. § 1.131 with the response dated April 13, 2006 is not effective to antedate Miles et al.. The reference to Miles et al. has an effective filing date of October 27, 2000. The Rule 131 Declaration appearing in the Evidence Appendix hereto establishes conception of the invention prior to the effective date of Miles et al., and also establishes due diligence from a period before the effective date of Miles et al., (October 27, 2000) until the filing of the present Application on November 28, 2000. We are, therefore dealing with a period of one month over which due diligence is an issue.

In the response submitted pursuant to 37 C.F.R. § 1.116 dated April 13, 2006, Appellants responded to the rejections of record with a new Declaration pursuant to 37 C.F.R. § 1.131, three copies of the Declaration having been submitted, each executed by one of the three Inventors. The Rule 131 Declaration demonstrates conception of the invention prior to October 27, 2000, the effective filing date of Miles et al., as evidenced by Exhibits A and N. The Declaration also

demonstrates due diligence from prior to the October 27, 2000 effective date of Miles et al. through November 28, 2000, the filing date of the present Application, as evidenced by Exhibits B through L. During this period of time, the Inventors herein collaborated with attorneys by telephone and e-mail in the preparation of drafts of the present Application. Such communications involved reviewing and suggested revisions of the drafts.

It is significant to note that: in paragraph 6 of the Declaration, the inventors declare under oath that they collaborated with attorneys Brian Russell and Paul Roberts at least by telephone and e-mail in their preparation of drafts of the present Application, reviewed the drafts and suggested revisions, as evidenced by Exhibits B-L; in paragraph 7 they declare under oath that Exhibit E denotes an e-mail message dated August 31, 2000 from attorney Brian Russell to co-inventor Lei Yao, explaining that a draft application was almost complete for co-inventor review; in paragraph 8, they declare under oath that Exhibit D denotes an e-mail message dated September 5, 2000, from co-inventor Lei Yao to attorney Brian Russell acknowledging receipt of the e-mail of Exhibit E; in paragraph 9, they declare under oath that Exhibit C denotes an e-mail message dated September 5, 2000, from attorney Brian Russell to co-inventor Lei Yao reporting an attached draft application for co-inventor review; in paragraph 10, they declare under oath that Exhibit B denotes an e-mail message dated October 5, 2000, from co-inventor Lei Yao to attorney Brian Russell reporting that attached consolidated co-inventor comments on a draft application; in paragraph 11, they declare under oath that Exhibit F denotes an e-mail message dated October 26, 2000 from attorney Brian Russell to all three co-inventors explaining his progress in revising the draft application; in paragraph 12 they declare under oath that Exhibit G denotes an e-mail message dated November 6, 2000 from attorney Brian Russell to all three co-inventors reporting an attached revised application for co-inventor review; in paragraph 13 they

declare under oath that Exhibit H denotes an e-mail message dated November 6, 2000 from attorney Brian Russell to the inventors reporting an attached revised application for review; in paragraph 14 they declare under oath that Exhibit I denotes an e-mail message dated November 8, 2000 from co-inventor Lei Yao to attorney Brian Russell acknowledging receipt of the revised applications for review; in paragraph 15 they declare under oath that Exhibit J denotes an e-mail message dated November 8, 2000 from attorney Brian Russell to the Inventors reporting an attached file for review related to the application for review; in paragraph 14 they declare under oath declared that Exhibit K denotes an e-mail message dated November 21, 2000 from Inventor Yao to attorney Paul Roberts reporting the attached consolidated inventor comments in preparation for a final draft; and in paragraph 15 they declare under oath that Exhibit L denotes an e-mail message dated November 22, 2000 from attorney Brian Russell to the Inventors reporting his incorporation of their comments into a final draft and requesting current address information for preparation of formal documents.

The Examiner's disposition of the probative value of the Declaration submitted pursuant to 37 C.F.R. § 1.131 is unrealistic, detached, plays fast and loose with Apellants' right to procedural due process of law and is legally erroneous. Adverting to page 11 of the August 25, 2006 Final Office Action, under the caption "Response to Arguments", the Examiner initially stated, in the 7th enumerated section, that "[t]he declaration submitted is not properly executed and does not adequately demonstrate prior invention. The examiner has bolded the important sections that were missed by the applicant." The Examiner then appears to paraphrase the MPEP and offers the following bolded comments.

As none of the conditions for signature by less than all the inventors has been demonstrated, the submission does not qualify as a proper declaration, is inadequate on its face and is entitled to no weight. The Examiner apparently overlooked the fact that three Declarations were submitted, one executed by each of the Inventors.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. . . . Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. . . . The applicant needs to show how the exhibits support the claimed invention. Merely pointing to exhibits and stating that they show the claimed invention is not sufficient. A clear explanation of how the exhibits support conception of the claimed invention must be part of the declaration.

It is not apparent what the Examiner wants. The Examiner's vague dismissal does not adequately apprise Appellants of the basis for the Examiner's holding. Appellants, therefore, cry foul in being denied their rights under procedural due process of law. (*In re Mullin*, 481 F.2d 1333, 179 USPQ 97 (CCPA 1973).

It is noted that the inventors unequivocally swore under oath in paragraph 4 that the Invention was conceived in this Country prior to October 27, 2000, the effective date of Miles et al. The inventors swore under oath that they prepared a description of the Invention and attached a copy thereof (Exhibit A). The inventors swore under oath that the description was prepared prior to October 27, 2000. Appellants submit that conception has been established prior to October 27, 2000.

As previously pointed out, in paragraphs 6 through 15, the inventors painstakingly refer to various exhibits and explain how they support due diligence in communications between them and their attorneys in preparation of the patent application. How many documented communications must be crammed into one month to satisfy the Examiner's interpretation of due diligence, which requires reasonably continuing activity based on all the evidence? *Michael S. Brown et al. v. Mariano Barbacid et al.*, #05-1119 decided by the CAFC on February 2, 2006. What more does the Examiner want? Saying the Declaration is not sufficient is not sufficient. *In re Mullin, supra*.

Appellants submit that the Examiner's summary dismissal of the Declaration submitted pursuant to 37 C.F.R. § 1.131 is tantamount to accusing the inventors of lying under oath without any reason to do so. The Examiner did not apply a rule of reason and consider the evidence as a whole including the sworn statements of the inventors, as the Examiner should have. *Ex Parte Ovshinsky*, 10 USPQ2d 1075 (BPAI 1989).

Based upon the foregoing, Appellants submit that the Examiner's disposition of the Declaration submitted pursuant to 37 C.F.R. § 1.131 is clearly legally erroneous. Appellants further submit that the Declaration clearly and effectively removes Miles et al. as a reference, thereby overcoming the imposed rejection of claims 2 through 6, 9, 20 through 24, 27, 37, and 38 under 35 U.S.C. § 102 for lack of novelty as evidenced by Miles et al.

Rejections 2 through 4.

As previously mentioned, Appellants do not separately argue the patentability of any of the dependent claims. Suffice it to say that absent Miles et al., the secondary references to Gai et al., Bullock et al. and Bowman-Amuah cannot support a *prima facie* basis to deny patentability to

the claimed inventions under any statutory provision, and the Examiner does not assert as much. Accordingly, the imposed rejections 2 through 4 under 35 U.S.C. § 103 are not factually or legally viable.

Summary.

In summary, the Declaration submitted pursuant to 37 C.F.R. § 1.131 is effective to remove Miles et al. as a reference by demonstrating prior invention prior to the effective date of Miles et al. Hence, none of the imposed rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 are factually or legally viable.

VIII. CONCLUSION AND PRAYER FOR RELIEF

Based on the foregoing, Appellants respectfully solicit the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

3/23/07

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IX. CLAIMS APPENDIX

2. The external processor of Claim 37, wherein the external processor includes a plurality of service controllers including said service controller, wherein each of said plurality of service controllers implements a respective one of a plurality of services.

3. The external processor of Claim 2, wherein the plurality of service controllers includes primary and secondary service controllers for a particular service among said plurality of services, and wherein the secondary service controller provides said particular service to said programmable access device if said primary service controller fails.

4. The external processor of Claim 2, wherein said plurality of service controllers includes a second service controller in communication with said first service controller such that a network message can be serviced by both of said first service controller and said second service controller.

5. The external processor of Claim 2, wherein the external processor is coupled to a plurality of programmable access device, and wherein at least one of the plurality of service controllers performs selectively service processing for a portion of said plurality of programmable access devices.

6. The external processor of Claim 37, wherein the service controller includes means for injecting a packet into a traffic flow handled by the programmable access device.

7. The external processor of Claim 37, wherein the service controller supports a service policy interface through which the service controller requests policy decision from a policy server.

8. The external processor of Claim 37, wherein the external processor includes a policy cache that selectively caches policies obtained from a policy server.

9. The external processor of Claim 37, and further comprising a reporting processor that provides an interface through which a reporting event received from the programmable access device is communicated to the service controller.

10. The external processor of Claim 37, and further comprising a signaling controller that transmits signals to configure network hardware to provide network connections.

11. The external processor of Claim 10, wherein the signals specify a quality of service.

12. The external processor of Claim 37, wherein the service controller comprises session management means for causing the programmable access device controller to signal the programmable access device to end a session receiving enhanced service.

13. The external processor of Claim 12, wherein the session receiving enhanced service is a Transport Control Protocol (TCP) session, and wherein the session management means comprises means for causing the programmable access device controller to signal the programmable access device to delete the TCP session state in response to a session activity level.

14. The external processor of Claim 37, wherein the service controller comprises a conference call service controller.

15. The external processor of Claim 37, wherein the service controller comprises an commerce service controller.

16. The external processor of Claim 37, wherein the service controller comprises an internet protocol telephony service controller.

17. The external processor of Claim 37, wherein the service controller comprises a reserved bandwidth service controller.

18. The external processor of Claim 37, wherein the service controller comprises a multicast service controller.

20. The method of Claim 38, wherein performing service processing comprises performing each of a plurality of services in response to network messages with a respective one of a plurality of service controllers.

21. The method of Claim 20, wherein the plurality of service controllers includes primary and secondary service controllers for a particular service among said plurality of services, and wherein the method further comprises:

in response to failure of communication with said primary service controller for said particular service, performing service processing utilizing the secondary service controller.

22. The method of Claim 20, wherein performing service processing comprises performing a plurality of services in response to a single network message utilizing a plurality of service controllers.

23. The method of Claim 20, wherein the external processor is coupled to a plurality of programmable access device, and wherein the method further comprises:

with at least one of the plurality of service controllers, performing service processing for less than all of said plurality of programmable access devices.

24. The method of Claim 38, wherein performing service processing includes injecting a packet into a traffic flow handled by the programmable access device.

25. The method of Claim 38, wherein performing service processing comprises requesting a policy decision from a policy server.

26. The method of Claim 25, and further comprising selectively caching, in a policy cache of the external processor, policies obtained from the policy server.

27. The method of Claim 38, and further comprising:

receiving a reporting message from the programmable access device; and
performing service processing with the service controller in response to the reporting message.

28. The method of Claim 38, and further comprising signaling network hardware from the external processor to provide a network connection.

29. The method of Claim 28, wherein signaling network hardware comprises specifying a quality of service for the network connection.

30. The method of Claim 38, wherein performing service processing comprises signaling the programmable access device to end a session receiving enhanced service.

31. The method of Claim 30, wherein the session receiving enhanced service is a Transport Control Protocol (TCP) session, and wherein signaling the programmable access device to end a session receiving enhanced service comprises signaling the programmable access device to delete the TCP session in response to a session activity level.

32. The method of Claim 38, wherein performing service processing comprises performing conference call service processing.

33. The method of Claim 38, wherein performing service processing comprises performing e-commerce service processing.

34. The method of Claim 38, wherein performing service processing comprises performing internet protocol telephony service processing.

35. The method of Claim 38, wherein performing service processing comprises performing reserved bandwidth service processing.

36. The method of Claim 38, wherein performing service processing comprises performing multicast service processing.

37. An external processor for a network access system having a programmable access device, comprising:

a message processor configured to parse a message for determining a type of communication service;

a service controller configured to receive the message if the type of communication service corresponds to the service controller, wherein the service controller determines a policy based on the message and generates a control signal according to the policy; and

a programmable access device (PAD) controller configured to receive the control signal for configuring a PAD to enforce the policy with respect to a network connection between a first network and a second network.

38. A method of providing a network access system with an external processor and having a programmable access device, comprising the steps of:

receiving a network message and parsing the message to determine a type of communication service with a network processor of the external processor;

determining a policy in response to the message with a service controller of the external processor;

generating and transmitting a control signal according to the policy; and

establishing a configuration of a programmable access device (PAD) to enforce the policy using the control signal with a PAD controller of the external processor in order to connect a first network and a second network.

X. EVIDENCE APPENDIX

Attached hereto is a copy of a Declaration submitted pursuant to 37 C.F.R. § 1.131 (three copies, each signed by one of the three Inventors). This Declaration was submitted with the response dated April 13, 2006 pursuant to 37 C.F.R. §1.116. The Examiner responded with another Final Office Action dated August 25, 2006 indicating that the August 25, 2006 Office Action was “responsive to the amendment filed on April 17, 2006.” In that Final Office Action the Examiner addressed the Declaration submitted pursuant to 37 C.F.R. § 1.131 filed with the response dated April 13, 2006.

XI. RELATED PROCEEDINGS APPENDIX

Not Applicable.